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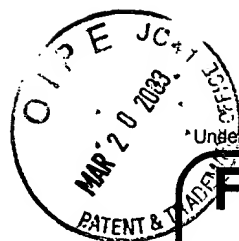
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TRANSMITTAL FORM (To be used for all correspondence after initial filing)	Application Number	09/431,849
	Filing Date	2 November 1999
	First Named Inventor	NICKEL, Oliver
	Group Art Unit	1774
	Examiner Name	Lawrence D. Ferguson
Total Number of Pages in This Submission	Attorney Docket Number	tesa AG 597-HCL

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
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Firm or Individual name	Howard C. Lee NORRIS McLAUGHLIN & MARCUS, P.A.	
Signature	<i>Howard C. Lee</i> Reg. No. 48,104	
Date	17 March 2003	
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Typed or printed name	Vilma I. Fernandez	
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☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) \$320.00

Complete if Known

Application Number 09/431,849
Filing Date 2 November 1999
First Named Inventor Oliver NICKEL
Examiner Name Lawrence D. Ferguson
Group Art Unit 1774
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Deposit Account Name

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☐ Charge any additional fee(s) during the pendency of this application

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	750	2001	375	Utility filing fee	
1002	330	2002	165	Design filing	
1003	520	2003	260	Plant filing fee	
1004	750	2004	375	Reissue filing	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

2. EXTRA CLAIM FEES FOR UTILITY AND

Extra Claims		Fee from below		Fee Paid
Total Claims	<input type="text"/> -20** = <input type="text"/> 0	X	<input type="text"/>	= <input type="text"/> 0.00
Independent Claims	<input type="text"/> -3** = <input type="text"/> 0	X	<input type="text"/>	= <input type="text"/> 0.00
Multiple Dependent			<input type="text"/>	= <input type="text"/>

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	84	2201	42	Independent claims in excess of 3	
1203	280	2203	140	Multiple dependent claim, if not paid	
1204	84	2204	42	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$) \$0.00

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FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non - English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	410	2252	205	Extension for reply within second month	
1253	930	2253	465	Extension for reply within third month	
1254	1,450	2254	725	Extension for reply within fourth month	
1255	1,970	2255	985	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	320.00
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,300	2453	650	Petition to revive - unintentional	
1501	1,300	2501	650	Utility issue fee (or reissue)	
1502	470	2502	235	Design issue fee	
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1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR § 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Statement	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	750	2809	375	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	750	2810	375	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	750	2801	375	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) \$320.00

SUBMITTED BY

Name (Print/Type)		Registration No. (Attorney/Agent)		Telephone	
Howard C. Lee		48,104		(212) 808-0700	
Signature		Date		17 March 2003	
Howard C. Lee					

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANTS : NICKEL, Oliver
SERIAL NO. : 09/431,849
FILED : 2 November 1999
FOR : MASKING STRIP AND USE THEREOF
ART UNIT : 1774
EXAMINER : Lawrence D. Ferguson

#22
3/28/03

17 March 2003

Hon. Commissioner of Patents
Washington, D.C. 20231

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 1.192

SIR:

This is an appeal from the final rejection dated 18 October 2003.

(1) REAL PARTY IN INTEREST

The real party in interest is **Beiersdorf AG** by virtue of an assignment recorded on at Reel 010561, Frame 0219 (Recorded on 10 April 2001).

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

(3) STATUS OF CLAIMS

Claims 2-9, 11 and 12 are pending. Although claim 11 has been withdrawn from consideration as drawn to a non-elected invention the appellants respectfully request that, upon allowance of elected subject matter, the non-elected subject matter be rejoined as claim 11 is a method of use claim which uses the product of claim 12.

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(4) STATUS OF AMENDMENTS

All amendments have been entered (2 November 1999; 17 July 2001; 1 March 2002). No amendment to the claims were made in the response to the final rejection dated 18 October 2002 (Paper No. 18).

(5) SUMMARY OF INVENTION

The present invention relates to a self-adhesive masking tape, comprised of:

- a) a heat-resistant adhesive tape comprising a paper support one side of which is coated with a contact adhesive;
- b) a masking paper adhered to and only partially covering said one side of said adhesive tape and having a width which extends from the locus of its adhesion to said one side of said adhesive tape to beyond one width boundary of said adhesive tape; and
- c) a masking film adhered to and only partially covering the part of said one side of said adhesive tape left uncovered by said masking paper, and which overlaps and covers said masking paper and has a width which exceeds the width of said masking paper .

(see claim 12 - support for this claim can be found from original claim 1, the specification (for example, page 6, lines 3-10 and the drawings)

Support for current claims 2-9 can found, for example, from claims 2-9 as originally presented. Support for claim 11 can be found, for example, from page 1, lines 2-5; page 4, lines 7-11 and original claim 10.

(6) ISSUES

The lone issue for consideration is the rejection under 35 U.S.C. § 103(a) of claims 2-9 and 12 by the examiner over Patel et al. (U.S. Patent 5,385,783) in view of Sakumoto et al. (U.S. Patent 5,683,806) and Leeuwenburgh (U.S. Patent 5,935,669).

(7) GROUPING OF CLAIMS

Claims 2-9 and 12 are related as being directed toward a self-adhesive masking tape. Claim 12 serves as the independent claim and claims 2-9 are dependent upon claim 12 which includes various limitations of the self-adhesive masking tape of claim 12.

(8) **ARGUMENT**

Differences Between the Appellants' Invention and the Prior Art

The ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion based on underlying findings of fact (see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000)). After practicing the fact-based inquiry set forth by *Graham v. John Deere Co.*, the examiner determined that the Patel reference differed from the applicants' invention in at least four different ways (text below is from page 2, paragraph 4 of the examiner's Office Action dated 10 April 2002):

"Patel does not disclose a film. While Patel does not disclose a specific width or thickness for the adhesive tape, he does state that the tape can be prepared into predetermined widths and lengths. Patel does not disclose that the masking film is folded. Patel does not disclose a polyolefin film"

The examiner later acknowledged that even with the combination of Patel and Sakumoto "Neither reference teaches the masking film being folded or the masking film extending beyond said second edge of the masking paper." (see page 3, paragraph 6 of the Office Action dated 10 April 2002).

The appellants have further argued that the Patel reference has additional differences with the appellants' invention in that the appellants invention requires that the contact adhesive is partially covered by masking paper (i.e. limitation b) in claim 12) and the remainder of the contact adhesive is covered by a masking film (i.e. limitation c) in claim 12. See simplified diagram of appellants' masking strip below:

Masking paper/Masking film
Contact adhesive layer
Paper support

Patel et al. does not teach or suggest the use of a masking paper/masking film on the contact adhesive layer. One of ordinary skill in the art would not be motivated to add this feature to the invention of Patel et al. because their adhesive layer 64 is protected by the release coat 60 as the tape is rolled up (see col. 2, lines 31-34).

When rolled, the release coat serves to protect both sides of the adhesive layer (see diagram of Patel's product below:)

Interior of roll of tape
64 – adhesive layer #1
58 – impregnated paper #1
60 – release coat #1
64 – adhesive layer #2
58 – impregnated paper #2
60 – release coat #2
64 – adhesive layer #3
58 – impregnated paper #3
60 – release coat #3
Exterior of roll of tape

***No Reason or Motivation to Combine References in Order to Address the Differences
Acknowledged by the Examiner***

The examiner previously stated that “Patel and Sakumoto are analogous art because they are from the same field of endeavor, that is masking tape....All references [including Leeuwenburgh] are analogous art because they are from the same field of adhesive tapes.” (see page 3, paragraphs 6 and 7 of the examiner’s Office Action dated 10 April 2002).

The appellants’ respectfully disagree with the characterization of the Sakumoto reference as analogous art there it is unclear that this is a masking tape (i.e. there is no indication that this tape contains a masking paper as in the appellants’ claimed invention); Sakumoto clearly states that their invention is directed toward an adhesive tape for electronic parts. Sakumoto discloses uses for compensating a shift of a lead pin in electronic parts, preventing a shorting of electronic parts and preventing a misalignment of wire bondings (see e.g. claims 6-9 of Sakumoto). However, even if *in arguendo* it was accepted that each of the references are “analogous” art, this would only establish that perhaps the references could be combined.

However, it has previously been held that “can be combined” is not the proper standard for establishing a *prima facie* case of obviousness. MPEP 2143.01 states that “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Neither the Patel or Sakumoto references teach or suggest making the appropriate modification to the teachings of Patel as described by the examiner ("...it is obvious to a person of ordinary skill in the art to combine the protective laminated adhesive layer of Sakumoto with the adhesive layer of Patel in order to provide protection for the adhesive layer of Patel so it would not lose its bonding properties.").

Even if proper to combine Patel with Sakumoto, the examiner acknowledged that "Neither reference teaches the masking film being folded or the masking film extending beyond said second edge of the masking paper." In order to address this difference, the Leeuwenburgh reference was additionally cited. However, Leeuwenburg while teaching a folding pattern, does not establish a teaching or suggestion as to why this folding pattern should be applied to the invention of Patel in combination with Sakumoto.

Moreover, the examiner appears to be factually incorrect with the statement "Although Leeuwenburgh does not explicitly teach his cover sheet is a masking strip, it comprises the same materials and has the same function as the applicants claimed masking strip, absent any evidence to the contrary." It is unclear whether the examiner really meant to establish equivalence between the cover sheet and either the masking paper? or the masking film? rather than the entire masking strip of the appellants' invention which the cover sheet clearly is not.

Even if the references are relied upon for what they teach and suggest as a collective whole, it has previously been held that "[i]t is **impermissible** within the framework of section 103 **to pick and choose** from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965))

More recently, it has been held that "...'Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.' see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d

1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d 546, 48 USPQ2d 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ('When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.')

see *Crown Operations Int'l., Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

If the examiner views the appellants' claimed self-adhesive masking strips as being "simple" technology, this still does not preclude providing a motivation to combine the references to arrive at the appellants' claimed invention nor does this lessen the standard for engaging in hindsight reconstruction. It was previously presented in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, (Fed. Cir. 1999) that:

"...Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. **Close adherence to this methodology is especially important in the case of less technologically complex inventions**, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.'...**Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.**"

This would appear to be especially pertinent for the present situation where multiple differences have been acknowledged by the examiner.

Patel Generically Teaches Rolls of Tape of Predetermined Widths and Lengths Not the Relationship of Measurements of the Tape Components

One of the difference acknowledged by the examiner was explained away as follows: "While Patel does not disclose a specific width or thickness for the adhesive tape, he does state that the tape can be prepared into predetermined widths and lengths." However, the statement referred to by the examiner (see col. 3, lines 43-44 of Patel) refers to the entire roll of tape. This does not address the difference with respect to the relationship of the sizes of the contact adhesive, masking paper and masking film as recited in the appellants' claim 12.

Patel Reference Teaches Away From Accepting the Modifications Proposed by the Examiner

The examiner argues that it would be obvious to add a masking film to the invention of Patel. However, in addition to the lack of motivation for making such a modification, the Patel reference teaches away from the making this modification as it is clear that the tapes of Patel are intended to be rolled up into a core (see e.g. col. 3, lines 41-44). As such, there is no reason to insert the masking film/masking paper (both of which are in contact with the adhesive layer) between the release coat and adhesive layer of Patel or substitute a masking film/masking paper for the release coat as the release coat also serves to protect the adhesive layer.

While it is well known that a prior art reference can be used for what it teaches and not just the claimed invention, MPEP 2141.02 makes the contingency that "A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention." (see MPEP 2141.02 and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). Even for the teaching pointed to by the examiner about the Patel reference (i.e. col. 1, lines 46-50), when this tape product is rolled up, the release coat and impregnated paper serve to protect the adhesive layer.

(9) CONCLUSION

For the foregoing reasons, Appellants respectfully request that the Honorable Board reverse the final rejections.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

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NORRIS, McLAUGHLIN & MARCUS, P.A.

By: Vilma I. Fernandez
Date 17 March 2003

(10) APPENDIX - CLAIMS ON APPEAL

2. Masking strip according to Claim 12, wherein the adhesive tape is a heat-resistant adhesive tape with a heat resistance of a maximum of 130°C (1 hour).
3. Masking strip according to Claim 12, wherein the adhesive tape is 15-75 mm wide.
4. Masking strip according to Claim 12, wherein the paper support is crepéd, stretchable and flexible and has good paint adhesion, and the entire adhesive tape has a thickness of 100-250 μm .
5. Masking strip according to Claim 12, wherein the masking paper is an unbleached kraft paper of 30-40 g/m^2 and a width of 15-50 cm.
6. Masking strip according to Claim 12, wherein the masking film is a polyolefin film 7-40 μm thick, which is corona pretreated, and is 0.5-2 μm wide.
7. Masking strip according to Claim 12, wherein the masking film is folded according to the dimensions of the masking paper and is folded against the latter accordion-wise.
8. Masking strip according to Claim 12, wherein the marginal area of the self-adhesive composition to which the masking paper adheres, is 1-5 mm wide.
9. Masking strip according to Claim 12, wound into a roll, the masking film being folded and the length of the roll corresponding approximately to the width of the masking paper plus the width of the adhesive tape.
11. A method for painting an automobile, wherein parts of the automobile are not to be painted, which comprises masking parts of said automobile which are not to be painted with a masking strip according to Claim 12.
12. A self-adhesive masking strip, comprised of
 - a) a heat-resistant adhesive tape comprising a paper support one side of which is coated with a contact adhesive;

- b) a masking paper adhered to and only partially covering said one side of said adhesive tape and having a width which extends from the locus of its adhesion to said one side of said adhesive tape to beyond one width boundary of said adhesive tape; and
- c) a masking film adhered to and only partially covering the part of said one side of said adhesive tape left uncovered by said masking paper, and which overlaps and covers said masking paper and has a width which exceeds the width of said masking paper .

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